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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,391	08/23/2005	Philippe Bastien	05725-1204	4451
22852	7590	07/22/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER KANAAN, MAROUN P	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/517,391

**Applicant(s)**

BASTIEN ET AL.

**Examiner**

MAROUN KANAAN

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 03/11/2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Status of Claims**

1. This action is in reply to the application 10517391 filed on 23 August 2005
2. Claims 1-91 are currently pending and have been examined.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:  
  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 1-91 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:
  - a. "(1) It is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines.');
  - Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or

operated to change materials to a 'different state or thing' '); *Cochrane v. Deener*, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').<sup>7</sup> A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (In re *Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or- transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (In re *Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post- solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion Ex parte Langemyr et al, (Appeal 2008-1495).

6. In the instant application there is not a sufficient tie to a particular machine, apparatus or a transformation of a particular article to a different state. Claims 1 and 36 sets forth the basis behind the claimed invention, but lacks any sufficient tie to a particular machine. Claims 2-35 and 37-91 are rejected for the same reasons.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, an alternative is given between selecting multivariable analysis or a tree segmentation technique. In claims 2-6, which are dependent on claim 1, the application shows that both multivariable analysis and tree segmentation had to be taught which is contrary to limitations in claim 1.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-18 and 20-26 are rejected under 35 U.S.C 102(b) as being anticipated by Huyn et al. (US 2002/0035486 A1).**

10. As per claim 1. Huyn teaches *a diagnostic method comprising:*
- *providing a first question* (See at least Para. 0014);

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- *receiving first information reflecting an answer to the first question* (See at least Para. 0014);
  - *selecting a second question according to the first information and according to a diagnostic algorithm generated using at least one of a multivariate analysis and a tree segmentation technique* (See at least Fig. 9B wherein a tree segmentation is shown);
  - *providing the second question* (See at least Fig. 6);
  - *receiving second information reflecting an answer to the second question* (See at least Fig. 9B);
  - *and determining a diagnosis according to the diagnostic algorithm* (See at least Para. 0100).
11. As per claims 2-6, Huyn teaches a tree segmentation technique (See at least Fig. 6), Huyn does not explicitly teach regression tree method, classification tree method, CART method etc. However each analysis is a design choice and it would of been obvious to use one of the mentioned analysis in this application. All of the mentioned analysis are similar in that they describe variability among observed variables, wherein the information gained about the interdependencies can be used later to reduce the set of variables in a dataset, and that is what Huyn teaches in his application.
12. As per claim 7, Huyn teaches *the method according to claim 1, wherein the first question is a most discriminating question according to the tree segmentation technique* (See at least Para. 0070, wherein the first question is the broadest question).
13. As per claim 8, Huyn teaches *the method according to claim 7, wherein the second question is, according to the tree segmentation technique and the answer to the first question, a second most discriminating question* (See at least Para. 0070 wherein the second question is the second broadest question and each question afterwards triggers a more specific question).
14. As per claim 9, Huyn teaches *the method according to claim 1, wherein at least one of the first information and the second information is received from a remote location over a network* (See at least Para. 0101, wherein the questionnaire can be completed over the web).

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15. As per claim 10, Huyn teaches *the method according to claim 9, wherein the network is at least one of an internet, an intranet, a wireless network, and a wired network* (See at least Para. 0101, wherein the questionnaire can be completed over the web).
16. As per claim 11, Huyn teaches *the method according to claim 1, wherein at least one of the first information and the second information is received from a portable electronic device* (See at least Para. 0101).
17. As per claim 12, Huyn teaches *the method according to claim 11, wherein the portable electronic device is at least one of a handheld personal computer, a telephone, a mobile phone, a television set, and a personal organizer* (See at least Para. 0047 wherein a handheld personal computer is taught).
18. As per claim 13, Huyn teaches *the method according to claim 1, further comprising:*
  - *selecting at least one subsequent question according to the diagnostic algorithm* (See at least Para. 0071);
  - *providing the at least one subsequent question* (See at least Para. 0071);
  - *and receiving subsequent information reflecting at least one answer to the at least one subsequent question* (See at least Para. 0071) .
19. As per claim 14, Huyn teaches *the method according to claim 13, wherein the selecting and providing of at least one subsequent question continues until the determining of the diagnosis* (See at least Fig. 10B).
20. As per claim 15, Huyn teaches *the method according to claim 1, wherein the diagnostic algorithm is a diagnostic algorithm generated by at least:*
  - *receiving, from a plurality of individuals, initial information reflecting answers to initial questions* (See at least Para. 0107);
  - *performing the multivariate analysis on the initial information received from the plurality of individuals to generate at least one synthetic variable* (See at least Fig. 18);
  - *and generating the diagnostic algorithm from at least the synthetic variable using the tree segmentation technique* (See at least Fig. 18).

21. As per claim 16, Huyn teaches *the method according to claim 1, wherein at least one of providing the first question and providing the second question comprises presenting, respectively, the first question or the second question at least one of over a network, at a kiosk, in a waiting room, at home, and at a point-of-sale* (See at least Para. 0101, wherein the questionnaire can be completed over the web).
22. As per claim 17, Huyn teaches *the method according to claim 16, wherein the network includes at least one of an internet, an intranet, a wireless network, and a wired network* (See at least Para. 0101, wherein the questionnaire can be completed over the web).
23. As per claim 18, Huyn teaches *the method according to claim 16, wherein the kiosk includes a display to present at least one of the first question and the second question* (See at least Fig. 10B).
24. As per claim 20, Huyn teaches *the method according to claim 1, wherein the diagnosis is at least one of a dermatological diagnosis, a beauty diagnosis, and a cosmetic diagnosis* (See at least Fig. 14 wherein a graphical analysis is displayed for skin care questions).
25. As per claim 21, Huyn teaches *the method according to claim 1, wherein the diagnosis relates to at least one of a skin characteristic and a keratin characteristic* (See at least Fig. 14 wherein a graphical analysis is displayed for skin care questions).
26. As per claim 22, Huyn teaches *the method according to claim 21, wherein the keratin characteristic relates to at least one of a hair, a nail, an eyelash, and an eyebrow* (See at least Fig. 15).
27. As per claim 23, Huyn teaches *the method according to claim 1, wherein the diagnosis relates to at least one of a skin condition and a keratin condition* (See at least Fig. 15).



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28. As per claim 24, Huyn teaches *the method according to claim 23, wherein the keratin condition relates to at least one of a hair, a nail, an eyelash, and an eyebrow* (See at least Fig. 15).
29. As per claim 25, Huyn teaches *the method according to claim 23, wherein the skin condition includes at least one of greasy skin, dry skin, aging skin, wrinkled skin, marked skin, flak skin, squeamish skin, sensitive skin, skin phototype, a pigmented spot of skin, a problem with an eyelid, skin topography, a sensitive lip, a wrinkle around a lip, acne, and eczema* (See at least Para. 0069).
30. As per claim 26, Huyn teaches the method according to claim 23, wherein the keratin condition includes at least one of hair loss, hair shine, hair thickness, hair oiliness, hair health, hair graying, and hair color (See at least Fig. 15).

**Claims 19, and 27-35 are rejected under 35. U.S.C 103(a) as being unpatentable over Huyn et al. (US 2002/0035486 A1) in view of Sun et al. (US 2002/0022973 A1).**

31. In regards to claim 19, Huyn teaches the claim limitations of claim 16, however Huyn does not explicitly teach but Sun teaches *wherein the point-of-sale is at least one of a product-selling store, a service-providing location, and a website* (See at least Sun, Para. 0114 the point-of-sale is a website). It would have been obvious to combine a computer-implemented questionnaire system for obtaining clinical data from subjects taught in Huyn with the questionnaire system offering recommended products for sale in Sun. The combination would enhance the way patients receive medical advice/services.
32. In regards to claim 27, Huyn teaches the claim limitations of claim 1, however Huyn does not explicitly teach but Sun teaches *further comprising selecting at least one product according to, at least in part, the diagnosis* (See at least Sun, Para. 0092 wherein prescribed or recommended medical treatment is taught). The motivation to combine both arts is the same as claim 19.
33. In regards to claim 28, Huyn teaches the claim limitations of claim 1, however Huyn does not explicitly teach but Sun teaches *further comprising offering the product for sale* (See at least Sun, Para. 0114). The motivation to combine both arts is the same as claim 19.
34. In regards to claims 29 and 30, Huyn teaches the claim limitations of claim 1, however Huyn does not explicitly teach but Sun teaches wherein the product includes at least one of a good and a service (See at least Sun, Para. 0114 wherein a good product is shown and Para. 0115 wherein a service product is shown). Sun does not explicitly teach the product is a beauty product but that is a design choice and does not alter the claim limitations of the application. The motivation to combine both arts is the same as claim 19.
35. In regards to claim 31, Huyn teaches the claim limitations of claim 1, however Huyn does not explicitly teach but Sun teaches *further comprising providing at least one of advice and a recommendation according to, at least in part, the diagnosis* (See at least Sun, Para. 0076). The motivation to combine both arts is the same as claim 19.

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36. In regards to claim 32, Huyn teaches the claim limitations of claim 1, however Huyn does not explicitly teach but Sun teaches *further comprising selecting at least one subject individual according to, at least in part, the diagnosis* (See at least Sun, Fig. 5H wherein a patient is selected). The motivation to combine both arts is the same as claim 19.
37. In regards to claims 33 and 34, Huyn teaches the claim limitations of claim 1, however Huyn does not explicitly teach but Sun teaches *wherein the subject individual exhibits a desired characteristic* (See at least Sun, Fig. 5i, wherein each patient exhibits a desired characteristic) Sun does not teach the desired characteristic is sensitive skin but that is a design choice and does not alter the claim limitations of the application. The motivation to combine both arts is the same as claim 19.
38. In regards to claim 35, Huyn teaches the claim limitations of claim 1, however Huyn does not explicitly teach but Sun teaches *further comprising evaluating a product on the subject individual* (See at least Sun Para. 0095 where a medical treatment is being physiological monitored as it is being administered to a patient). The motivation to combine both arts is the same as claim 19.

Claims 36-91 recite the same claim limitations as claims 1-35 and therefore are rejected for the same reasons as above.

### Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Naeem Haq** whose telephone number is **571.272.6758**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Naeem Haq** can be reached at **571.272.6758**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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Maroun Kanaan

July 13, 2009

Art Unit 4135

/Naeem Haq/  
Supervisory Patent Examiner, Art Unit 4135